

REMARKS

Claims 1, 6-8, 10, 11, 13-16, and 18 are pending in this application.

Applicants have amended claims 1, 7, and 11, and have canceled claim 17. These changes do not introduce any new matter.

Claim Objection

In response to the objection to claim 7, Applicants have amended this claim to correct the informality noted by the Examiner. In particular, Applicants have amended claim 7 to change the dependency of this claim from claim 5, which was previously canceled, to claim 1. Accordingly, Applicants request that the objection to claim 7 be withdrawn.

Rejection under 35 U.S.C. § 103

Applicants respectfully request reconsideration of the rejection of claims 1, 6-8, 10, 11, and 13-18 under 35 U.S.C. § 103(a) as being unpatentable over *Fukui et al.* (“*Fukui*”) (US 5,517,621) in view of *Nojima et al.* (“*Nojima*”) (US 5,930,811) (as noted above, claim 17 has been canceled). As will be explained in more detail below, the combination of the *Fukui* and *Nojima* references would not have rendered the subject matter defined in independent claims 1 and 11, as amended herein, obvious to one having ordinary skill in the art.

Applicants have amended independent apparatus claim 1 to include the features specified in claim 17. Applicants have amended independent method claim 11 along the same lines that claim 1 has been amended. In light of the changes to claim 1, claim 17 has been canceled.

In formulating the obviousness rejection, the Examiner asserts that the *Nojima* reference discloses the features of claim 17 (see the Office Action at page 10), which features are now incorporated in independent claims 1 and 11. Applicants respectfully traverse the Examiner’s characterization of the *Nojima* reference relative to the claimed subject matter.

The *Nojima* reference discloses a document processing apparatus. In particular, the *Nojima* reference discloses inserting one part such as an illustration into all of the associated fields in a layout when the part is selected from among the parts list, which shows the parts which can be inserted into the associated field in the layout. The *Nojima* reference, however, does not disclose inserting several illustrations in an order of selection of the illustrations when the several illustrations are selected. As such, the *Nojima* reference does not disclose or suggest that when multiple built-in images are selected, the selected multiple built-in images are integrated into the at least one image integration area of the selected template in an order of selection of the multiple built-in image and in the priority order, as specified in the claimed subject matter. Further, there is no disclosure or suggestion of these features in the *Fukui* reference.

Thus, for at least the foregoing reasons, even if the *Fukui* and *Nojima* references were to be combined in the manner proposed by the Examiner, the result of this combination would not have included each and every feature of the subject matter defined in present claims 1 and 11. Therefore, the combination of *Fukui* in view of *Nojima* would not have rendered the subject matter defined in present claims 1 and 11 obvious to one having ordinary skill in the art.

Accordingly, independent claims 1 and 11, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Fukui* in view of *Nojima*. Claims 6-8, 10, 14, 15, and 18, each of which depends from claim 1, and claims 13 and 16, each of which depends from claim 11, are likewise patentable under 35 U.S.C. § 103(a) over the combination of *Fukui* in view of *Nojima* for at least the same reasons set forth above regarding the applicable independent claim.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1, 6-8, 10, 11, 13-16, and 18, as amended herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. ITECP015).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

/Peter B. Martine/

Peter B. Martine
Reg. No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
Customer Number 25920